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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,551	09/11/2000	Isao Echizen	58799-024	4689

7590 01/02/2004

McDermott Will & Emery
600 13th Street NW
Washington, DC 20005-3096

EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/659,551

Applicant(s)
Isao Echizen et al.

Examiner
Pierre E. Elisca

Art Unit
3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/08/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47 is/are allowed.
- 6) ☒ Claim(s) 15-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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Examiner Pierre Eddy Elisca

United States Department of Commerce

Patent and Trademark Office

Washington, D.C. 20231

DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 10/08/2003.
2. Claims 25-47 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-30 and 33-46 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Matsumoto et al. (U.S. Pat. No. 6,320,829) in view of Lacy et al. (U.S. Pat. No. 6,266,419).

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As per claims 25, 26 and 33-46 Matsumoto substantially discloses a copy of digital data from a digital recording medium is controlled so as to prevent unauthorized copying. The digital data is transmitted from a transmitter-side to a receiver-side (which is seen to read as Applicant's claimed invention wherein it is stated that a contents rendering control for tailoring of electronic data or a method of controlling filtering of contents data in reproducing or distributing);

wherein control information specifying predetermined filtering has been embedded in the contents data as a digital watermark (see., col 4, lines 7-26, specifically wherein it is stated that the electronic watermark information judgment device determines one of two copy restriction levels from the electronic watermark information, Applicant duly note that the electronic watermark device rendering control of the application information);

extracting the control information from the contents data; deciding how to execute the predetermined filtering of the contents data based on the extracted control information; filtering a predetermined portion of the contents data according to the decision; and reproducing or distributing of the filtered contents data (see., col 4, lines 7-26, col 3, lines 35-67, col 16, lines 31-51, specifically judging device).

Matsumoto fails to explicitly disclose wherein said the contents data comprise a predetermined portion that has been embedded in the contents. However, Lacy discloses a method of compressing media content in which a first predetermined portion of a media content is compressed using a first data-based compression algorithm (see., abstract, col 1, lines 35-67, col 2, lines 9-32). Accordingly, it would have been obvious to a person of ordinary skill in the art at the invention was made to

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modify the digital copy of Matsumoto by including the limitation detailed above as taught by Lacy because this would secure the compressed media content against unauthorized use.

As per claims 27, 28, 29, 30 and 32 Matsumoto discloses the claimed method wherein the control information includes one or more items of level information for determining whether the predetermined filtering is to be applied to a specific portion of the contents data; and the step for filtering comprises determining whether the predetermined filtering is applied to a specific portion of the contents, based on one or more items of the level information included in the control information (see., col 6, lines 5-60).

ALLOWABLE SUBJECT MATTER

5. Claim 47 is allowed over the prior art of record.

Conclusion

6. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

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Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

(703) 305-7687



Pierre Eddy Elisca

Patent Examiner

December 11, 2003